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EXAMINER

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/783,241
Filing Date: February 14, 2001
Appellant(s): COCCHI ET AL.

Georgann S. Grunebach
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 6/22/06 appealing from the Office action mailed 2/17/06.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

US 2002/0055847 A1	Nakano et al.	05-2002
US 2002/0056118 A1	Hunter et al.	05-2002
US 2003/0023703 A1	Hayward et al.	01-2003
6,166,778	Yamamoto et al.	12-2000
5,291,554	Morales	03-1994
5,544,161	Bigham et al.	08-1996
EP 898425 A2	Wool	02-1999

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 40-43, 48-52, 57-61 and 66 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Nakano in view of Hunter.

As to claim 40, Nakano discloses a method for receiving subscriber information (Fig. 6) comprising:

(a) receiving, in a set top box (10, paragraph 27), broadcast signals (paragraph 22, lines 1-7) through a tuner of the set top box (wherein a tuner is inherently present to tune to a broadcast channel; paragraph 22, lines 4-7); and

(b) enabling a presentation device (television 12) connected to the set top box to display the broadcast signals (paragraph 22, lines 1-7);

(c) automatically connecting (the set top makes a connection when the card is entered; paragraph 34, lines 1-3) to the Internet (Fig. 5; paragraph 26, lines 1-8) using a communication module (a modem; paragraph 26, lines 5-8) of the set top box (paragraph 26, lines 5-8) without the user requesting the connection (wherein connection takes place upon entry of the card; paragraph 33, lines 6-12 and paragraph 34, lines 1-3), wherein the communication module is different the tuner (Fig. 1; paragraph 22).

While Nakano discloses receiving information from the Internet (for home shopping; paragraph 31, 36 and 37), he fails to specifically disclose receiving a subscriber renewal notice over the connection to the Internet.

In an analogous art, Hunter discloses a video distribution system (Fig. 4; paragraph 12) wherein a user will receive broadcast video for display on a television (paragraphs 65 and 70) and will automatically connect to the Internet through a modem (87, paragraph 51, lines 16-18 and 31-34 and paragraph 67) to receive monthly subscriber renewal notices (monthly renewed security codes to ensure a site is authorized to view the movie; paragraphs 79, 82 and 83) for the typical benefit of ensuring that only authorized subscribers who are current on their payments may receive and display videos (paragraph 79).

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Nakano's system to include receiving a subscriber

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renewal notice over the connection to the Internet, as taught by Hunter, for the typical benefit of ensuring that only authorized subscribers who are current on their payments may receive and display the received content.

As to claim 49, Nakano discloses a system for receiving information (Fig. 6) comprising:

a set top box is configured to:

receive broadcast signals (paragraph 22, lines 1-7) through a tuner (wherein a tuner is inherently present to tune to a broadcast channel; paragraph 22, lines 4-7); and

enable a presentation device (television 12) connected to the set top box (Fig. 1) to display the broadcast signals (paragraph 22, lines 1-7);

automatically connect (paragraph 34, lines 1-3) to the Internet (Fig. 5; paragraph 26, lines 1-8) using a communication module (a modem; paragraph 26, lines 5-8) of the set top box (paragraph 26, lines 5-8) without the user requesting the connection (paragraph 33, lines 6-12 and paragraph 34, lines 1-3), wherein the communication module is different than the tuner (Fig. 1; paragraph 22).

While Nakano discloses receiving information from the Internet (for home shopping; paragraph 31, 36 and 37), he fails to specifically disclose receiving a subscriber renewal notice over the connection to the Internet.

In an analogous art, Hunter discloses a video distribution system (Fig. 4; paragraph 12) wherein a user will receive broadcast video for display on a television (paragraphs 65 and 70) and will automatically connect to the Internet through a modem

(87, paragraph 51, lines 16-18 and 31-34 and paragraph 67) to receive monthly subscriber renewal notices (monthly renewed security codes to ensure a site is authorized to view the movie; paragraphs 79, 82 and 83) for the typical benefit of ensuring that only authorized subscribers who are current on their payments may receive and display videos (paragraph 79).

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Nakano's system to include receiving a subscriber renewal notice over the connection to the Internet, as taught by Hunter, for the typical benefit of ensuring that only authorized subscribers who are current on their payments may receive and display the received content.

As to claim 58, Nakano discloses an article of manufacture for receiving information (Fig. 6) comprising:

means for a set top box (Fig. 1; 10) connectable to a presentation device (Fig. 1; 12) to receive broadcast signals (paragraph 22, lines 1-7) through a tuner (a tuner is inherently present to tune to a broadcast channel; paragraph 22, lines 4-7);

means for the set top box (10) to enable the presentation device (television, 12) to display the broadcast signals (paragraph 22, lines 1-7);

means (a modem; paragraph 26, lines 1-9) for the set top box to automatically obtain a connection (paragraph 34, lines 1-3) to the Internet (Fig. 5; paragraph 26, lines 1-8) using a communication module (a modem; paragraph 26, lines 5-8) of the set top box (paragraph 26, lines 5-8) without the user requesting the connection (paragraph 33,

lines 6-12 and paragraph 34, lines 1-3), wherein the communication module is different the tuner (Fig. 1; paragraph 22).

While Nakano discloses means for receiving information from the Internet (a modem for home shopping; paragraph 31, 36 and 37), he fails to specifically disclose receiving a subscriber renewal notice over the connection to the Internet.

In an analogous art, Hunter discloses a video distribution system (Fig. 4; paragraph 12) wherein a user will receive broadcast video for display on a television (paragraphs 65 and 70) and will automatically connect to the Internet through a modem (87, paragraph 51, lines 16-18 and 31-34 and paragraph 67) to receive monthly subscriber renewal notices (monthly renewed security codes to ensure a site is authorized to view the movie; paragraphs 79, 82 and 83) for the typical benefit of ensuring that only authorized subscribers who are current on their payments may receive and display videos (paragraph 79).

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Nakano's system to include receiving a subscriber renewal notice over the connection to the Internet, as taught by Hunter, for the typical benefit of ensuring that only authorized subscribers who are current on their payments may receive and display the received content.

As to claims 41, 50 and 59, Nakano and Hunter disclose wherein the subscriber renewal notice is traditionally broadcast via satellite (decryption codes to utilize broadcast video; see Hunter at paragraph 83), the method further comprising receiving

broadcast information that utilizes satellite bandwidth no longer consumed by the subscriber renewal notice (see Hunter at paragraphs 51 and 83).

As to claims 42, 51 and 60, Nakano and Hunter disclose wherein the subscriber renewal notice comprises service provider facility data that is used by the set top box on a monthly basis (used to access the video; see Hunter at paragraphs 79 and 83).

As to claims 43, 52 and 61, Nakano and Hunter disclose establishing a secure electronic connection (see Nakano at paragraph 34, lines 1-9) with a server (see Nakano at column 30, lines 1-5) through the connection to the Internet (see Nakano at paragraph 26, lines 1-9), wherein the subscriber renewal notice is received through the secure electronic connection (see Hunter at paragraph 83).

As to claims 48, 57 and 66, while Nakano and Hunter disclose wherein the automatically obtaining a connection comprises:

if an Internet connection is currently established (to allow transmission over the Internet; see Nakano at paragraph 32), automatically (see Nakano at paragraph 32, lines 4-7) obtaining a new transmission protocol/internet protocol (TCP/IP) connection (wherein an Internet connection is in TCP/IP protocol; see Nakano at paragraph 32) through the communication module using the established Internet connection (see Nakano at paragraph 26, lines 5-12), he fails to specifically disclose determining if an Internet connection is currently established.

The examiner takes Official Notice that it is notoriously well known in the art to include means to determine if a system currently has an established Internet connection for the typical benefit of avoiding failed data transmissions due to a lack of an Internet connection.

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Nakano and Hunter's system to include determining if an Internet connection is currently established for the typical benefit of avoiding failed attempts to conduct a shopping transaction due to a lack of an Internet connection.

Claims 46, 47, 55, 56, 64 and 65 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Nakano and Hunter as applied to claims 40, 49 and 58 above, and further in view of Hayward.

As to claims 46, 55 and 64, while Nakano and Hunter disclose the set top box automatically connecting to a computer (DB2; see Nakano at paragraph 30, lines 1-5), without the user requesting a connection (the set top automatically makes a connection when the card is entered; see Nakano at paragraph 34, lines 1-3), using the communications module (a modem connecting through telephone lines to the Internet; see Nakano at paragraph 26; lines 5-14), wherein the communications module is a modem (see Nakano at paragraph 26, lines 5-14), they fail to specifically disclose receiving a local phone number, dialing the local phone number and establishing a

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connection to the Internet through a computer that answers the dialed local phone number.

In an analogous art, Hayward discloses a computer system (Fig. 2) wherein a local telephone number provided to the user system (paragraph 20, lines 10-12) is dialed to make a connection (to the POP; paragraph 20, lines 6-15) using a modem (34) to establish a connection to the Internet through a computer (the POP connecting to the Internet backbone; paragraph 20, lines 4-21) that answers the dialed phone number (paragraph 20, lines 4-8) for the typical benefit of providing a means for a user to connect to the Internet through their phone line (paragraph 20, lines 1-8).

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Nakano and Hunter's system to include receiving a local phone number, dialing the local phone number and establishing a connection to the Internet through a computer that answers the dialed local phone number, as taught by Hayward, for the typical benefit of allowing a user a simple way to connect to the Internet through a local phone number.

As to claims 47, 56 and 65, Nakano, Hunter and Hayward disclose wherein the local phone number is associated with an Internet service provider (see Hayward at paragraph 20, lines 1-6).

Claims 44, 45, 53, 54, 62 and 63 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Nakano and Hunter as applied to claims 40, 49 and 58 above, and further in view of Yamamoto.

As to claims 44, 53 and 62, while Nakano and Hunter disclose receiving purchase information (user indication of a good or service to purchase; see Nakano at paragraphs 31, 34 and 35), for a good or service purchased by a user (see Nakano at paragraph 31 and 35), wherein the purchase information was obtained through the user communicating with a set top box (obtained in response to a previous user purchase; see Nakano at paragraphs 31, 34 and 35); and

transmitting the purchase information (see Nakano at paragraph 31, lines 7-13) from the set top box (wherein the connection is made from the set top modem; see Nakano at paragraph 26, lines 5-8) to a server (to server, 46; see Nakano at paragraph 34, lines 6-15) through the connection to the Internet (see Nakano at paragraphs 31-34), they fail to specifically disclose storing the purchase information for the good or service in the set top box.

In an analogous art, Yamamoto discloses a broadcast receiver (Fig. 1) which can perform purchasing (column 37, lines 16-30) wherein user purchase information is stored in the broadcast receiver (charge record information table stored in a IC card; Fig. 43; column 37, lines 48-60) and retrieved for later display to a user (column 37, line 61-column 38, line 13) for the typical benefit of providing a means for a user to easily retrieve and review their purchasing history at a later time (column 38, lines 14-24).

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Nakano and Hunter's system to include storing the purchase information for the good or service in the set top box, as taught by Yamamoto, for the typical benefit of providing a means for a user to easily review and verify their purchasing history at a later time.

As to claims 45, 54 and 63, Nakano, Hunter and Yamamoto disclose wherein the purchase information is stored in a smart card (IC card; see Yamamoto at Fig. 43; column 37, lines 48-60).

(10) Response to Argument

In response to appellant's arguments on pages 4-5, in regards to the advisory action, it is noted that the references were provided to specifically rebut appellant's arguments regarding the inherency of a claimed benefit.

The three references Morales, Bigham and Wool were all provided as clear showings of the state of the art with the typical transmission of decryption keys via the broadcast channels, which was disputed by appellant.

Claims 40, 49 and 58

On page 6, appellant argues that the "plain language" of a subscriber renewal notice indicate that it is a renewal for a subscriber and is not a key for a particular movie that is delivered on a monthly basis.

Hunter discloses a video distribution system wherein security keys (code key C) are distributed to the user on a monthly basis (paragraph 82 and 83) via the Internet (paragraph 51, 67 and 82). A code key is provided for **each** movie only if the user is current in payments and in good standing (paragraph 82).

Thus, based upon the "plain language" of the term subscriber renewal notice, Hunter clearly meets the current limitations.

The code keys C for **all of the** available movies are provided on a *monthly basis* (see paragraph 82) if the subscriber is current in payments (paragraph 82). Thus, the subscriber's *video subscription* is being renewed every month. The available security keys for all of the available movies, which the user has paid to access, are then renewed every month if the user has paid their bill.

The code keys C are provided to the subscriber system to ensure that only subscribers may playback the movie (paragraphs 82 and 83). Thus the code keys C provide *notice* to the *subscriber* system on how to access and utilize the movies.

Further, it is not any individual key for a particular movie which is being renewed, but all of the keys for the currently available movies for the month. The video service is paid for and renewed on a monthly basis, and the paying subscriber's system is then notified of the current security keys required for playback.

Finally, in regards to the meaning of a "subscriber renewal notice", it is noted that appellant's specification provides no specific definition beyond "pay-TV service facility data" (page 2, lines 25-29) which is received on a *monthly basis* (page 2, lines 8-11).

As the security keys disclosed by Hunter are provided for a pay television service to renew access to the currently available movies, it clearly meets all of the current limitations and definitions of a "subscriber renewal notice".

In page 6, paragraph 2, appellant argues that Hunter describes the delivery of a key for a particular movie over a phone/modem on a monthly basis and not providing a renewal notice for a particular subscriber over a connection to the Internet.

In response, as indicated above, Hunter discloses the delivery of keys for all of the movies (paragraph 82) to a particular subscriber (limited to a subscriber who is current in their payments; paragraphs 82-83) over a connection to the Internet (Internet modem connection; paragraph 51, lines 17-19 and paragraphs 82-83) renewed on a monthly basis (paragraph 82). This clearly meets the current broad claim limitations.

In response to appellant's arguments on page 6, regarding "code key B", it is noted that these keys were not relied upon or cited within the current rejections. The fact that Hunter discloses multiple batches of different keys does not alter the fact the specifically cited security keys (code keys C) clearly meet the current claim limitations. Hunter's disclosure of additional keys which are not transmitted over the Internet is irrelevant.

On page 6, appellant argues that the code key C is not a renewal for a subscriber, as the keys change when the movies change. Thus nothing is being "renewed" as new keys are provided.

In response, it is once again noted that the code keys C are only provided to the subscriber if they are current in their payments (paragraph 82).

Thus, it is the subscriber's video service which is being renewed every month. The new batch of code keys C provide *notice* to the subscriber system on the renewal to allow for playback of the available movies.

In response to appellant's arguments on page 7, that the subscriber renewal notice is understood to renew a "package" for the subscriber,

1. It is noted that the definition appellant is attempting to provide to the subscriber renewal notice, i.e. as pertaining to some sort of "package", as opposed to a particular movie, is not supported by the current specification, which does not define what the renewal notice pertains to.

2. As previously indicated, Hunter discloses wherein a subscriber will receive, on a monthly basis, code keys for EACH available movie. While not necessarily required by the current claim limitations, the current rejections are based upon the receipt of all of the code keys C. These keys together constitute the subscriber renewal notice, as they are renewed on a monthly basis, based upon the subscriber's payment for the service, to provide access to movies.

In response to appellant's arguments on page 7, it is once again noted that the code keys C constitute a subscriber renewal *notice*. A new batch of keys is provided every month, dependent on the subscriber making their payments. Thus, it is the video *service* which is being renewed. The code keys C constitute the *notice* to the subscriber system of the renewal and the renewed means to access the movies.

Despite appellant's repeated assertions, the rejection is not based upon any individual key for a movie being provided each and every month to the subscriber. It is the batch of code keys C which *together* comprise the renewal notice, as it constitutes a renewal of the subscriber's service. While individual available movies may change over time, the service (and corresponding keys to provide access to that service) have been renewed.

In response to appellant's arguments on pages 7-8, regarding to the description of the term "subscriber renewal notice" in appellant's specification, it is noted that a "subscriber renewal notice" is referred to as operator facility data (page 14, lines 6-8) and pay-TV service provider facility data (page 2, lines 25-29). No specific recitation of what actually constitutes a "subscriber renewal notice" is ever described.

While appellant argues that the term cannot be limited to "pay-TV service provider facility data" as the phrase "operator facility data" was also used, a pay-TV service provider would seem to clearly qualify as an "operator". It is unclear as to how this would effect the current rejections, as the code keys provided by Hunter clearly qualify as "data" and are provided by a "pay-TV service provider" or "operator".

Finally, in response to appellant's arguments on page 8, regarding what would constitute a "subscriber renewal notice" and unrelated example appellant has created, it is once again noted that the claims merely recite a subscriber renewal notice. No specifics are provided as to what a subscriber renewal notice would entail.

Therefore, to clarify, the claim can be broken down:

Subscriber: Are the code keys C for a particular subscriber? Yes, as they are provided to an individual subscriber's system responsive to that subscriber making their payments (paragraph 82).

Renewal: Is something being renewed? Yes, as the subscriber video service is renewed on a monthly basis. The security keys for the movies are then renewed to allow access to the current available movies for the month.

Notice: Is notice being provided? Yes, as the subscriber system is provided notice regarding the access and playback of the movies for the next month.

Thus, Hunter's code keys C clearly meet the current claim limitations.

Further, although not specifically claimed, one can further look as the usage of a "subscriber renewal notice" in appellant's disclosure.

Are the code keys "pay-TV service provider facility data"? (page 2, lines 25-29). Yes, as the code keys C are data provided by pay-TV service provider to allow access to distributed movies.

Are the code keys “operator facility data”? (page 14, lines 6-10). Yes, as the code keys C are data provided for by pay-TV service provider (i.e. *operator*) to allow access to distributed movies.

Are the code keys transmitted monthly? (page 14, lines 6-10). Yes, as the code keys C are provided monthly to the subscriber when they are current on their payments.

Are the code keys typically broadcast? (page 14, lines 6-10). Yes, security keys for decrypting video content are typically broadcast. In response to appellant’s traversal of this basic fact, three references, Morales, Bigham and Wool, were provided which clearly show that it was known to transmit keys within the broadcast signal.

Thus, despite appellant’s repeated arguments, Hunter’s code keys C clearly meet every required claim limitation.

Claims 41, 50 and 59

On pages 9-10, appellant argues that there is no disclosure within Hunter that the code keys C are transmitted via satellite or traditionally transmitted via satellite.

In response, Hunter discloses the transmission of video decryption keys via the Internet. As indicated in the rejections, the broadcast transmission of the decryption keys for video programming is traditional and typical. Multiple references (Morales at column 5, lines 24-59; Wool at paragraphs 13-14 and 19-20; and Bigham at column 5, lines 26-44) were then provided to appellant which clearly show that this was known.

Thus, Hunter discloses transmitting a "subscriber renewal notice" (code keys C), which is traditionally transmitted via broadcast (as shown by Morales, Wool and Bigham), via the Internet.

As decryption keys are typically and known to be transmitted via the broadcast signal, transmission of the keys via the Internet, as opposed to the broadcast signal, saves broadcast bandwidth. Appellant's assertion that a limitation is somehow being "ignored" is incorrect. Transmitting the decryption keys through the Internet instead of the broadcast signal inherently saves broadcast bandwidth, as less data is then being transmitted through the broadcast channel.

In response to appellant's arguments on page 11, it is again noted that Hunter discloses the transmission of a subscriber renewal notice (consisting of decryption keys for programming) via the Internet. As has been repeatedly shown, decryption keys are typically and known to be transmitted via the broadcast signal. Thus, Hunter provides the additional inherent benefit of saving broadcast bandwidth.

Further, it is noted that appellant's disclosure clearly indicates that a subscriber renewal notice are traditionally broadcast (see page 2, lines 9-11). As Hunter clearly meets the limitations of a subscriber renewal notice, as shown above in regards to claims 40, 49 and 58, appellant's own specification indicates that these notices would traditionally be broadcast via satellite.

Claims 42, 51 and 60

In response to appellant's arguments on pages 11-12, regarding claims 42, 51 and 60, please see above wherein it has clearly been shown that a video decryption key transmitted by a television service provider would clearly meet the limitation of "service provider facility data".

Claims 43, 52 and 61

In response to appellant's arguments on page 12, regarding a secure electronic connection, it is noted that Nakano, and not Hunter, was relied upon to disclose the use of a secure electronic connection to connect with the Internet (see Nakano at paragraphs 34 and 26). Nakano was then combined with Hunter to disclose transmitting the subscriber renewal notice through the secure electronic connection. Thus, it is the combination of Nakano and Hunter which teach the current claim limitations.

Claims 46, 47, 55, 56, 64 and 65

In response to appellant's arguments on pages 12-13, in regards to the combination of Hayward with Nakano and Hunter, Nakano specifically discloses wherein the input device, while envisioned as a set top box, can constitute any device having access to the network (paragraph 12), even explicitly including a PC (paragraph 12). Thus, as Nakano clearly defines his set top box as being synonymous with a computer connecting to a network, one of ordinary skill in the art would clearly

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recognize Hayward's computer, which connects to the Internet as analogous art.

Furthermore, as indicated in the rejection, the relied upon feature and motivation, of allowing dial-up connection to the Internet, is unrelated to the particular network device, and would be relevant to any network computing device.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

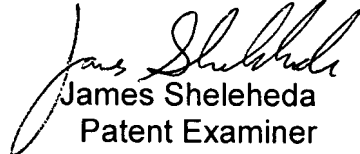
Respectfully submitted,

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